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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,622	08/30/2001	Kairi Ann Johnston	10017682-1	9262

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,622

Applicant(s)

JOHNSTON ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,9-11,14-16,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,9-11,14-16,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 10/24/05, and has been entered and made of record. Currently, **claims 1-5, 9-11, 14-16, 19, and 20** are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-3, 5, 9-11, 14, and 15** are rejected under 35 U.S.C. 102(b) as being anticipated by Iijima (U.S. Patent Number 6,031,975).

Regarding *claim 1*, Iijima discloses a scanning method (see Figs. 1-12) for providing scan data to a host computer (interpreted as the destination of a facsimile transmission) interconnected to a scanning device (interpreted as the client 2 having a scanner 5 attached) via a server (interpreted as the server 3), the method comprising displaying a host identifier (ID) for identifying a host computer (see Fig. 8, and column 5, lines 13-31, wherein the telephone number of the destination of a facsimile transmission is displayed), receiving user input selecting the host ID (see Fig. 8, and column 5, lines 13-31), scanning a document or image to generate scan data (column 5, lines 13-31), and transmitting the scan data to the host computer (column 5,

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lines 13-63, and column 7, lines 53-60), wherein the displaying, the receiving, the scanning and the transmitting are performed by the scanning device and not the server (column 5, lines 13-63).

Regarding *claim 2*, Iijima discloses the method discussed above in claim 1, and further teaches that the host ID is displayed in response to receiving user input requesting a scan (see Figs. 3, 7, and 8).

Regarding *claim 3*, Iijima discloses the method discussed above in claim 1, and further teaches of displaying a plurality of host identifiers at the scanning device (see Fig. 8, whereby a plurality of addresses are shown as being “abbr.1”, “abbr.2”, etc.).

Regarding *claim 5*, Iijima discloses the method discussed above in claim 1, and further teaches that the host computer is a PC (column 3, lines 26-47).

Regarding *claim 9*, Iijima discloses a scanning device (interpreted as the client 2 having a scanner 5 attached, see Fig. 1) for providing scan data to a host computer (interpreted as the destination of a facsimile transmission) via a server (interpreted as the server 3), the scanning device comprising memory for storing a host identifier (ID) (column 5, lines 13-63), an image sensing module for scanning an image or document (scanner 5, column 5, lines 13-63), where the scanning is used to generate scan data (column 5, lines 13-63), and a display panel for displaying the host ID (see Fig. 8, and column 5, lines 13-31, wherein the telephone number of the destination of a facsimile transmission is displayed), where the scanning device transmits the scan data to the host computer that is identified by the host ID in response to receiving user input selecting the displayed host ID and without the user directly accessing the server (column 5, lines 13-63, and column 7, lines 53-60).

Regarding **claim 10**, Iijima discloses the device discussed above in claim 9, and further teaches of means for transmitting a scanning request to the host computer (column 5, lines 13-63, and column 7, lines 53-60), and means for receiving a scanning instruction from the host computer (column 3, lines 20-52, and column 5, line 64-column 6, line 54).

Regarding **claim 11**, Iijima discloses the device discussed above in claim 9, and further teaches that the host computer is a PC (column 3, lines 26-47).

Regarding **claim 14**, Iijima discloses the device discussed above in claim 9, and further teaches that the image sensing module comprises a CCD or a CIS (column 4, lines 3-32).

Regarding **claim 15**, Iijima discloses the device discussed above in claim 9, and further teaches that the scanning device is a flat-bed scanner, a sheet-fed scanner, or a multifunction device (column 4, lines 3-32).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 4, 16, 19, and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima (U.S. Patent Number 6,031,975) in view of Lo *et al.* (U.S. Patent Number 5,911,044, cited in the Office action dated 7/22/05).

Regarding **claim 4**, Iijima discloses the method discussed above in claim 1, but fails to expressly disclose if prior to displaying the host ID, receiving registration data containing the

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host ID from the host computer, and if prior to scanning the image or document, transmitting a scanning request to the host computer and receiving a scanning instruction from the host computer.

Lo discloses a scanning method (see Fig. 14) comprising displaying a host identifier (ID) for identifying a host computer (column 20, lines 43-50, with the host computer being interpreted as the client computer 102), receiving user input selecting the host ID (column 20, lines 43-61), scanning a document or image to generate scan data (column 21, lines 9-19), and transmitting the scan data to the host computer (column 21, lines 9-40). Further, Lo teaches that prior to displaying the host ID, receiving registration data containing the host ID from the host computer (column 19, lines 29-62), and prior to scanning the image or document, transmitting a scanning request to the host computer and receiving a scanning instruction from the host computer (column 19, line 63-column 20, line 23).

Iijima & Lo are combinable because they are from the same field of endeavor, being systems that control network scanners. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Lo within the system of Iijima. The suggestion/motivation for doing so would have been that the system of Iijima would become more user-friendly, as user's would be able to register addresses for use with the system, before any scanning is performed, as recognized by Lo in column 19, lines 29-62. Therefore, it would have been obvious to combine the teachings of Lo with the system of Iijima to obtain the invention as specified in claim 4.

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Regarding *claim 16*, Iijima and Lo disclose the method discussed below in claim 19, and Lo further teaches of transmitting a request to the scanning device requesting a cancellation of registration (column 22, lines 24-60).

Iijima & Lo are combinable because they are from the same field of endeavor, being systems that control network scanners. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Lo within the system of Iijima. The suggestion/motivation for doing so would have been that the system of Iijima would become more user-friendly, as user's would be able to register addresses for use with the system, before any scanning is performed, as recognized by Lo in column 19, lines 29-62. Therefore, it would have been obvious to combine the teachings of Lo with the system of Iijima to obtain the invention as specified in claim 16.

Regarding *claim 19*, Iijima and Lo disclose the method discussed above in claim 4, and Lo further teaches that the request for registration is transmitted in response to user input requesting registration with the scanning device, in response to the host computer powering up, in response to a user logging on to the host computer, or in response to a user logging on to a network to which the host computer is coupled (column 19, lines 29-62).

Iijima & Lo are combinable because they are from the same field of endeavor, being systems that control network scanners. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Lo within the system of Iijima. The suggestion/motivation for doing so would have been that the system of Iijima would become more user-friendly, as user's would be able to register addresses for use with the system, before any scanning is performed, as recognized by Lo in column 19, lines 29-62. Therefore, it would

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have been obvious to combine the teachings of Lo with the system of Iijima to obtain the invention as specified in claim 19.

Regarding *claim 20*, Iijima and Lo disclose the method discussed above in claim 16, and Lo further teaches that the request for cancellation of registration is transmitted in response to user input requesting cancellation of registration, in response to the host computer powering down, in response to a user logging off from the host computer, or in response to a user logging off from a network to which the host computer is coupled (column 22, lines 17-60).

Iijima & Lo are combinable because they are from the same field of endeavor, being systems that control network scanners. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Lo within the system of Iijima. The suggestion/motivation for doing so would have been that the system of Iijima would become more user-friendly, as user's would be able to register addresses for use with the system, before any scanning is performed, as recognized by Lo in column 19, lines 29-62. Therefore, it would have been obvious to combine the teachings of Lo with the system of Iijima to obtain the invention as specified in claim 20.

Citation of Pertinent Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Czyszczewski *et al.* (U.S. Patent Number 6,577,907) discloses a modular multifunction device.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622



jrp